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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,873	03/16/2004	Masakatsu Kiwada	011350-329	1558
21839 7590 04/15/2010 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER				
CRUZ, IRIANA				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/800,873

Applicant(s)

KIWADA, MASAKATSU

Examiner

IRIANA CRUZ

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1.7.13.18 and 32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1.7.13.18 and 32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species II in the reply filed on 1/11/2010 is acknowledged.
2. Applicant mention that claims 21-23, 25-27, 29, 31 and 34 where not included in the species mentioned and in the event that examiner find this claims not to be part of the elected species to explain why these claims would be mutually exclusive form species elected. Claims 21-23, 25-27, 29, 31 and 34 describes an image forming device where when a judgment unit judges that there is no electronically tagged matter scanning of the image is performed while, Species II specifies that when the judging unit judges that there is no electronically tagged matter printing a blank paper as an output is the action to be taken where nowhere in claims 21-23, 25-27, 29, 31 and 34 is described that the action to be taken when no electronic tag is found is printing a blank paper as a result, therefore these claims are mutually exclusive as recited.
3. Examiner also notices that Claim 33 does not reads on species II it reads on species III therefore is not included under claims that read on to elected species II.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 7, 13, 18 and 32 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant argues that Teraura does not disclose "an electronic tag storing original image data" also "a printing paper judgment unit for judging whether there is an instruction for printing the original image data". Examiner respectfully disagrees. Taking

a second look at Teraura this two limitations are taught by Teraura and this is explained in the new rejection presented below. On the claims there is no specification of what an original image data is, therefore the most broadest interpretation would be that by original data its referring to the original data that was copied to be printed, if the RFID tag is found, when printing the information and instructions (permission for copy and printing) will include copying the content of the RFID unless instructed to not be permitted to copy therefore Teraura's teachings read on the claim how its being claimed. Also the Teraura's permission instructions that can be found on the RFID read on the instruction because if access is not permitted by reading the RFID tag it is instructed to not copy or print therefore Teraura's read on the limitation of the claims, a more detailed claim limitation would be necessary.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 7, 13, 18 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terarura (US Patent Number 6,827,279 B2) in view of Nishigai et al. (US Patent Number 5,825,911).

Regarding **Claim 1**, Terarura'279 shows an image forming device comprising: a transporting unit for transporting a document sheet by sheet to a

specified reading position (i.e., **image reading means for reading an image on a sheet of paper of a document; document paper feeder. See Column 2, Lines 29-30, See Column 5, Lines 39-43 and See Figure 2, Element 4**); a document judgment unit for judging whether the document transported by said transporting unit is an electronically tagged printed matter that includes an electronic tag storing original image data (i.e., **detecting/judging means that detect if the paper includes an RFID/electronic tag, where the electronic tag includes image data to be printed, if the document with RFID tag is copied and printed allowance of copying all the data in this case considered the original image data to be copied is permitted therefore the original data is copied to print. See Column 1, Lines 50-65, Column 2, Lines 10-38 and Column 7, Lines 3-50, Column 8, Lines 22-55**); a printing paper judgment unit for judging whether there is an instruction for printing the original image data on an electronically tagged printing paper equipped with an electronic tag (i.e., **paper feeding means having a first paper tray with electronic tags and second paper tray with paper without electronic tags, when a detection of electronic tag is done the printer prints using the electronically tagged paper, when the RFID tag is found and read, permission data is received also from the RFID Tag which instructs that access to the image data (original) to be copied and print is allowed therefore the data being copied becomes the original data and the permission data instructs allowing to copy and print. See Column 1, Lines 30-65 and Column 2, Lines, 1-26 and see Column 7, Lines 3-50, Column 8, Lines 22-55**); a reading unit for reading the data from the electronic tag of the document which is judged as said

electronically tagged printing matter by said document judgment unit, when said printing paper judgment unit judges that there is an instruction for printing on an electronically tagged printing paper equipped with a electronic tag (i.e., **a RFID data reading means to read data from the electronic tag, permission data included on the RFID functions as an instruction to allow printing of the original data that was copied to print. See Column 1, Lines 30-65 and Column 2, Lines, 1-40, Column 7, Lines 3-50, Column 8, Lines 22-55 and Column 12, Lines 30-67**); and a printing unit for printing the data on an electronically tagged printing paper equipped with an electronic tag, wherein the data is read by said reading unit (i.e., **printing detected page data with electronic tag on a paper from the tray with electronic tags. See Column 1, Lines 30-65, Column 7, Lines 3-50, Column 8, Lines 22-55 and Column 12, Lines 30-6**).

Terarura'279 fails to show said printing step to issue a blank paper as an output, when a document is judged one specific way.

Nishigai'911 teaches a printing step to issue a blank paper as an output, when a document is when a document is judged one specific way (i.e., **an image forming apparatus that by means of a light source to inspect a document judges the authenticity of a document if the document is judge with forgery the image forming apparatus outputs a blank sheet of paper. See Column 2, Lines 58-66, Column 3, Lines 9-13 and See Column 13, Lines 43-45**).

Having the method of Terarura'279 and then given the well-established teaching of the Nishigai'911, it would have been obvious to one having ordinary skill in the art at

the time of the invention was made to modify the method of Teraura'279 as taught by the Nishigai'911 by adding to the image forming apparatus with electronic tag judging means the step of printing a blank page when a judgment is done, in this case if its judged that there is no electronic tag on the paper being read, the printed blank page will let the user know there is no electronic tag for the printer to print, since printing a blank page helps improve the method by letting the user know its trying to print unauthorized/invalid information and protects forgery/errors as suggested in reference Teraura'279 Column 2, Lines 55-57.

With regards to method **Claim 7**, the limitation of the claim 7 are corrected by limitation of claim 1 above. The steps of claim 7 read into the function step of claim 1.

With regards to method **Claim 13**, the limitation of the claim 13 are corrected by limitation of claim 1 above. The steps of claim 13 read into the function step of claim 1.

Regarding **Claim 18**, Terarura'279 shows a computer-readable medium storing an image forming program of claim 13, wherein said electronic tag transmits or receives electronic data by means of wireless communications (i.e., the **RFID/electronic tag transmits and receives data through radio waves signals. See Column 4, Lines 22-23 and 49-51).**

Regarding **Claim 32**, Terarura'279 shows an image forming device further comprising: a writing unit for writing the original image data read by said reading unit into the electronic tag of an electronically tagged printing paper equipped with a

electronic tag (i.e., **detecting/judging** means that detect if the paper includes an RFID/electronic tag, where the electronic tag includes image data to be printed, if the document with RFID tag is copied and printed allowance of copying all the data in this case considered the original image data to be copied is permitted therefore the original data is copied to print. See Column 1, Lines 50-65, Column 2, Lines 10-38 and Column 7, Lines 3-50, Column 8, Lines 22-55); wherein said printing unit is only allowed to print the original image data read from the electronic tag when a document is an electronically tagged printed matter and its electronic tag does not store copy prohibiting information (i.e., **paper feeding** means having a first paper tray with electronic tags and second paper tray with paper without electronic tags, when a detection of electronic tag is done the printer prints using the electronically tagged paper, when the RFID tag is found and read, permission data is received also from the RFID Tag which instructs that access to the image data (original) to be copied and print is allowed therefore the data being copied becomes the original data and the permission data instructs allowing to copy and print. See Column 1, Lines 30-65 and Column 2, Lines, 1-26 and see Column 7, Lines 3-50, Column 8, Lines 22-55); said writing unit is only allowed to write the original image data into the electronic tag of an electronically tagged printing paper equipped with an electronic tag when a document is an electronically tagged printed matter and its electronic tag does not store copy prohibiting information; and said printing unit issues a blank paper as an output and said writing unit does not write the original image data into the electronic tag of an electronically tagged printing paper

equipped with an electronic tag, when a document is judged not as an electronically tagged matter by said document judgment unit while said printing paper judgment unit judges that there is an instruction for printing on a printing paper equipped with a electronic tag (i.e., **a RFID data reading means to read data from the electronic tag, permission data included on the RFID functions as an instruction to allow printing of the original data that was copied to print. See Column 1, Lines 30-65 and Column 2, Lines, 1-40, Column 7, Lines 3-50, Column 8, Lines 22-55 and Column 12, Lines 30-67).**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to IRIANA CRUZ whose telephone number is (571)270-3246. The examiner can normally be reached on Monday-Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Y. Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

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April 9, 2010

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